



#5
Reconsideration
S. Zimmerman 714

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. 09/663,661 Art Unit: 3714
Applicant: Thomas S. Abbott Examiner: Capron, Aaron J.
Invention: A REEL GAME REQUIRING SKILL TO WIN
Filing Date: 9-15-2000

RESPONSE TO FIRST OFFICE ACTION

Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir or Madam:

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This is written in response to an Office Action having a mailing date of March 29, 2002.

Claim Rejections 35 U.S.C. § 102

Claim 1 and 2, 10 and 11, and 26 and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nolte et al., U. S. Patent #6,615,070. The Examiner reasons that the Nolte patent displays a plurality of reels (Figure 4) that appear to rotate by successively projecting on video screen images on different locations on the video screen. The reels are a plurality of predetermined fixed symbols for each plurality of reels. There is a stop means controlled by the player and a

means to determine if the player has stopped one of the predetermined fixed symbols within a predetermined location on the video screen. The Applicant respectfully traverses the Examiner's conclusions and in the following paragraphs will explain his reasoning.

General Comments

As was explained in the Background of the Invention in the Applicant's application, games are subject to a variety of regulatory environments. Games of skill may be allowed in a regulatory environment where games of chance are not allowed. The Applicant's invention is designed to be a game of skill and is described and claimed as such. This is in contrast to the Nolte patent. The Nolte patent is described as a game of skill but, in fact, the operation of the Nolte invention is not based on skill, but rather is based on luck and a skillful player cannot consistently "beat" the Nolte game. It is important that this be clarified at the beginning, because the features of the Applicant's invention which make it a game of skill are the features that distinguish it from the Nolte patent and are reasons why the Nolte patent is not a 102 reference.

Applicant's Invention Compared To The Nolte Patent

In the Applicant's preferred embodiment, as shown in Figure 1, there are three reels (41, 42, and 43). Each of these reels rotates, causing symbols to appear and apparently move from the top of the view window to the bottom of the view window then to pass out of view. The rotation in the electronic embodiment is described in detail for Figure 5. As described in Figure 5 of the Applicant's invention, there are necessarily at least two symbols that are shown and are completely visible at any given time on each reel (41, 42, 43). The importance of this to the Applicant's invention is described in the portion of the application called "Timing of the Game" which begins at the middle of page 25 of the application and extends to the bottom of page 30. In effect, in order

for a player to have any opportunity to exercise coordination, memory, and skill in order to stop a symbol within the required frame in order to obtain a pay off, at least two symbols must be visible on the display of the reel at any time.

This is in contrast to the Nolte device. Although Figure 4 shows nine “frames” that are apparently similar to the Applicant’s invention, in fact, there is really only one frame in play. That is to say while there are nine frames there are also nine reels. Unlike the Applicant’s invention, in Nolte a symbol does not rotate, for example, from frame 30 to frame 33 to frame 36 in Figure 4 of the Nolte invention. This is explained in the Nolte disclosure for Figure 3A. This shows frame 31 and the rotation of symbols V, Z, and Q through frame 31. The Nolte invention requires that less than two symbols are displayed in frame 31. [This is in contrast to the Applicant’s invention, which both discloses and requires the display of at least two symbols on the visible part of a reel (41, 42, or 43)]. The requirement of less than two symbols or display is explained in column 4 of the Nolte invention where it explains that grids 33, 34, and 35 are the basic version and that the claims are meant to cover that 3-grid configuration. This is explained in more detail in column 5 in line 2. This explains in grid 31 icon “R” is fully displayed but icons “Q” and “T” are only fractionally displayed. The application goes on to state that: “What is most critical is that only a single icon is fully displayed at any particular moment” (Column 5, line 54-55) (Emphasis added) Moreover, in the Nolte device pressing the STOP button initiates a “stop active command” (column 11, lines 16-17). As is further explained, pressing the STOP button does not immediately stop the rotating images within a grid. This requires the operator to “lead” the apparent icon rotation within a single grid. This time delay is built in the machine and is not in any way adjusted for a player’s reaction time nor does it consider a player’s reaction time. This is in contrast to the current invention which does not have a time delay between the pressing of the STOP button by

the player and the freezing of an icon's rotation in the display.

Argument

In order for a patent application to serve as a bar under § 102 it must disclose all claimed elements in the claim at issue. There can be no anticipation under 102 if there is an exclusion of a claimed element from the reference. Atlas Powder Company v E.I. du Pont, de Nemours & Co., 224 USPQ 409, 411 (1984). In the current application, there are three independent claims, Claim 1, Claim 10, and Claim 26. For Claim 1, Subsection (c) requires that at least two symbols must be displayed on a reel so that they may be visually perceived by a player. Claim 10 requires means for displaying a plurality of the predetermined fixed symbols. Claim 26 requires providing a means for displaying on said reel a plurality of predetermined fixed symbols. The Nolte reference limits the display to no more than one fully displayed symbol. Consequently, Claims 1, 10, and 26 have a limitation which requires either a plurality of symbols or at least two symbols be displayed. This limitation is not disclosed in the Nolte reference. Indeed, the Nolte patent teaches away from the current invention. The Nolte patent requires no more than one symbol be fully displayed at any one time, whereas the current invention claims that at least two symbols be displayed. Therefore, the Nolte invention cannot be a 102 reference for independent Claims 1, 10, and 26. Since the Nolte patent cannot be an 102 reference for Claims 1, 10, and 26, it cannot be a 102 reference for dependent claims 2, 11, and 27. However, the Applicant will note in passing that the added limitation of "1/10 of a second" in Claims 2, 11, and 27 is not simply a matter of a variable time adjusted by the software. Without the teaching of this invention and, more specifically, the teaching of the timing of the invention as referenced above, there would be no reason to adjust the software to 1/10 of a second to allow this minimum reaction time. Moreover, the Nolte patent again teaches away from the current invention by requiring a predetermined lapse of time between the time the

player presses the STOP button and the time the symbol is stopped. This is in contrast to the current invention, which gives a player a predetermined minimum time to press the STOP button in order to give the player a reasonable chance to stop a symbol within a predetermined location.

Claim Rejections Under 35 U.S.C. § 103

The Examiner combines the Sakamoto U.S. Patent #6,306,034 with the Nolte patent to hold Claims 3-9, 12-25, and 28-35 unpatentable under 35 U.S.C. § 103. However, adding the Sakamoto patent does not remedy the essential deficiencies of the Nolte reference as described above. Consequently, the remaining claims are not obvious under § 103.

Conclusion

The Applicant has shown that there is a claimed element in each independent Claim 1, 10, and 26, which is not disclosed in the Nolte patent. Moreover, the Nolte patent actually teaches away from the Applicant's invention by requiring less than two symbols be visible at any time, whereas the current application requires at least two symbols be visible in a given window or frame. The Applicant further explains the limitation added in Claims 2, 11, and 27 regarding the 1/10 of a second are not a mere matter of choice but are, in fact, representative of a minimum reaction time. Consequently, the Nolte patent cannot serve as an anticipatory 102 reference for Claims 1-2, 10-11, and 26-27. The addition of Sakamoto to the Nolte patent does not remedy the essential deficiencies of the Nolte patent as a reference. Consequently, the remaining dependent claims are not anticipated by the combination of Sakamoto with Nolte. The Applicant, having fully answered the rejections of the Examiner, believe the application is now in a condition for allowance and respectfully requests the same.

This the 5 day of June, 2002.

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CERTIFICATE OF SERVICE

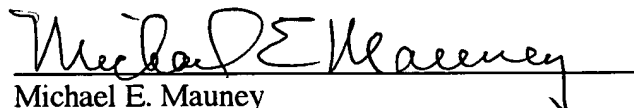
I, Michael E. Mauney, do hereby certify that a copy of the foregoing Response to First Office Action has this day been duly served upon:

Commissioner of Patents and Trademarks
Box NO FEE
Washington, DC 20231

Said service was made in the following manner:

- () By handing such copy to the aforementioned attorney, or by leaving said copy at the above mentioned attorney's office with a partner or employee of his office.
- (x) By depositing a copy of the aforementioned document(s) enclosed in a prepaid first class addressed envelope in the U. S. Mail.

This the 5 day of June, 2002.



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